

**UNITED STATES DISTRICT COURT
DISTRICT OF MARYLAND**

JAYLEN BANTLEY et al.,

Plaintiff,

v.

EPIC GAMES, INC. et al.,

Defendants.

Civil Action No. 8:19-cv-00594-PWG

The Honorable Paul W. Grimm

**PLAINTIFFS' MEMORANDUM OF LAW
IN OPPOSITION TO DEFENDANTS' MOTION TO DISMISS**

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I. INTRODUCTION

In the age of digital information, the motion of the human body can be as valuable as a person's face or name—if not more so. Motion capture of Andy Serkis resulted in one of the most memorable characters in the *Lord of the Rings* movie franchise, Gollum, and widespread acclaim for that performance. The primary antagonist in *Star Wars Episode VII*—the most popular movie of all time at the domestic box office—was another motion capture performance. In the *Fortnite Battle Royale* video game (“*Fortnite*”), Epic Games, Inc. (“Epic”) seeks to profit off movements that others have created and made famous by selling and advertising these movements as dance emotes in the *Fortnite* electronic storefront.

Fortnite is a popular video game that is offered for free—at least to start. In operation, however, *Fortnite* brings in billions of dollars in direct revenue for its owner, Epic. The game does so through a controversial and exploitative practice known as microtransactions¹, in which *Fortnite* users purchase virtual goods and unlock features within the game through small payments (often ten dollars or less). Dance “emotes”—such as the *Running Man* emote at issue here—are a large and lucrative category of items that *Fortnite* players can purchase or unlock through microtransactions. Epic takes dances that others made famous, digitally copies them, and sells them to players so that their in-game avatars can perform these dances. Epic justifies profiting off this copying by creating a legal fiction that either (1) Plaintiffs' claims are preempted by the Copyright Act, or (2) using the First Amendment as a sword. These arguments are invalid.

First, Epic's copyright preemption argument fails because Plaintiffs do not allege that the

¹ Dave Smith, *I miss the days when I only had to pay once for a video game*, BUSINESS INSIDER, Apr. 22, 2015, available at <https://www.businessinsider.com/microtransactions-are-ruining-video-games-2015-4>.

Running Man is a choreographic work protectable under the Copyright Act, and Plaintiffs' claims contain elements that bring them outside the scope of preemption. While it may be considered a dance, a dance and a choreographic work are not the same thing. Unsurprisingly, Epic ignores case law which expressly holds that claims predicated on works not protected by copyright are not preempted by the Copyright Act.

Second, regardless of which state's law applies, Maryland, Massachusetts, or New Jersey law recognize to Plaintiffs' right of publicity claims.

Third, Epic's use of the First Amendment as a sword to justify their blatant theft is unavailing. Even applying the Transformative Use Test, it is clear that Epic's wholesale lifting of Plaintiffs' famous dance is not sufficiently transformative. Here, Epic digitally coded Plaintiffs' signature dance into its video game, determined its price, then sold it to players.

Fourth, *Rogers v. Grimaldi* does not bar the trademark or unfair competition claims. *No Doubt*, 192 Cal. App. 4th 1018 (2011) holds that *Rogers v. Grimaldi* does not apply to unfair competition claims when there is no transformative use. Moreover, *Rogers* also does not apply to claims under 15 U.S.C. § 1125(a) because the analysis does not apply to purely commercial uses. Plaintiffs' claims center on Epic's *sale* of the *Running Man* within the *Fortnite* electronic storefront, and commercial works such as these are immune to *Rogers*. And, even if the Court holds that *Rogers* applies to the unfair competition claims, these claims withstand the *Rogers* test because not only does Epic mislead customers, but using the *Running Man* in *Fortnite* has no artistic relevance to the game—indeed, it was added solely as part of Epic's microtransaction monetization model.

II. RELEVANT FACTUAL BACKGROUND

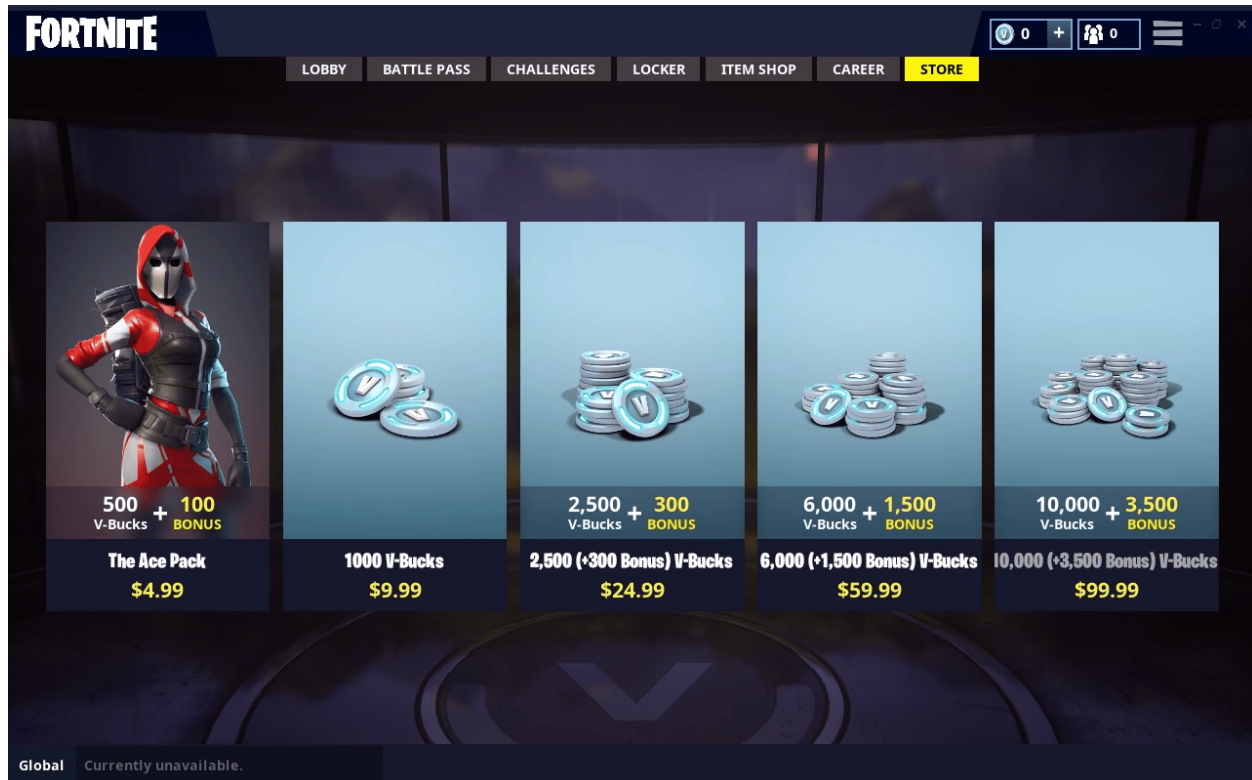
Fortnite is a video game using a “battle royale” format where up to one hundred players, alone or in groups, fight to be the last player or group remaining. Amended Complaint (Dkt. No.

18) (“Am. Comp.”), ¶ 17. The game is free to play. Where it makes money is through “microtransactions”—smaller purchases (often \$10 or less) that the player can make within the game. The game includes a digital storefront which serves as an online marketplace for these microtransactions. Players obtain in-game currency called “V-Bucks”—obtained using real currency—to purchase and unlock various in-game content such as in-game avatars, “skins” (which are alternate appearances), and dance emotes. *See id.*, ¶ 18.

Dance emotes are incredibly popular. *Fortnite* players use these emotes to enable their in-game avatars to perform various dances, whether to celebrate, to taunt other players, or any other reason. Epic takes dances that are made famous by others and sells them to *Fortnite* players for use within the game. The emote at issue here, the *Running Man*, was made famous in 2016 by Plaintiffs while they were basketball stars at the University of Maryland and has become synonymous with them. *See id.*, ¶¶ 9-13. Without seeking or obtaining Plaintiffs’ consent, Epic digitally copied their signature dance into *Fortnite* and even called it by the same name. *See* Declaration of David Hecht, Ex. 1, 0:31 – 1:12 (“Ex. 1”) (video acknowledging that the in-game *Fortnite* dance emote is the same as Plaintiffs’ real-life counterpart). Epic’s emote duplicates Plaintiffs’ Running Man precisely, including: (1) motion of the arms, with bent elbows; (2) hand motion, including the thumbs and/or pinky fingers being extended at various times; (3) swaying of the head during the dance; and (4) footwork. Epic sells the *Running Man* to players by offering it in the game’s electronic storefront for 500 V-Bucks (approximately \$5), or as a reward for purchasing a Season Battle Pass. Am. Comp., ¶ 26.

The *Fortnite* electronic marketplace is like Amazon.com—except that it only offers virtual goods for the *Fortnite* game. First, a player must have currency in the form of V-Bucks to purchase items. As depicted below, players can purchase currency in the *Fortnite* electronic

storefront.



The top of the screen indicates several “tabs” that may be selected by players, including “Battle Pass,” “Item Shop” and “Store.” These features comprise the *Fortnite* electronic marketplace; they are different than the *Fortnite* battle royale itself, in which players can actually play the “game.”

In the electronic marketplace, players can browse, or purchase, items in the Item Shop or view details about the current Battle Pass available for purchase. Players can select icons that represent various features that are available. For example, the following icon represented the “Running Man” dance emote. Upon clicking this icon, the emote would be displayed in the storefront.



A screenshot of the *Fortnite* electronic storefront depicting a young African-American male avatar (not included among the nine avatars Epic presents in its brief)² performing the *Running Man* emote is shown below:



After viewing or purchasing items and customizing his or her avatar, a player can proceed to play the game. Below is a screenshot of actual gameplay in the battle royale *Fortnite* game.

² Epic describes that the nine avatars shown “do not resemble Brantley or Nickens” (Br. at 5). However, Epic omits many of the other avatars available for players, some of which do resemble Plaintiffs.



While playing the game, characters may perform the emote(s) purchased in the Item Shop or otherwise unlocked, but players cannot purchase those items.

III. STANDARD OF REVIEW

On a motion to dismiss, the Court must accept as true all of the factual allegations in the complaint. *E. I. du Pont de Nemours & Co. v. Kolon Indus.*, 637 F.3d 435, 440 (4th Cir. 2011) (citations omitted). All reasonable inferences are drawn in favor of the plaintiff. *Id.*

IV. ARGUMENT

A. The Copyright Act Does Not Preempt Plaintiffs' Claims

A two-part test is used to determine whether a claim is preempted under Section 301 of the Copyright Act: “(1) whether the claim ‘falls within the subject matter of copyright’ and (2) whether the claim ‘protects rights that are equivalent to any of the exclusive rights of a federal copyright.’” *See Tire Eng’g & Distrib., LLC v. Shandong Linglong Rubber Co.*, 682 F.3d 292, 309 (4th Cir. 2012) (citation omitted). Preemption occurs only where both prongs of this test are satisfied. *Id.* Here, Epic fails both.

Under the first prong, Epic argues that because “choreography is the subject matter of copyright ... the first prong [of the preemption analysis] is satisfied.” Memorandum of Law in Support of Defendant’s Motion to Dismiss (“Br.”) at 9. As an initial matter, it is odd that Epic argues that the claims relate to choreography when they previously urged that the *Running Man* is not protected by copyright at all. *See* Dkt. No. 17 at 2. This Court should not countenance Epic’s efforts to talk out of both sides of its mouth. In any event, Plaintiffs do not allege that the *Running Man* is a choreographic work, nor are the claims based on one.³ Epic is confusing a “choreographic work” with a “dance,” but the two are not the same. *See* U.S. Copyright Office, Compendium of U.S. Copyright Office Practices (3rd ed. 2017) § 805.1 (“choreography is not synonymous with dance”). Indeed, the latter is not copyrightable (unless it includes protectable choreography, which neither party has alleged), and accordingly Epic fails the first prong of the preemption test. *See* *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992) (abrogated on other grounds) (rejecting copyright preemption for a voice, which was not copyrightable); *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988) (same); *Prima v. Darden Restaurants, Inc.*, 78 F. Supp. 2d 337, 352-53 (D.N.J. 2000) (same).

Epic’s attempt to attach the *Running Man* to an audiovisual work (the 2016 YouTube video) in order to bring Plaintiffs’ claims within the subject matter of copyright is unavailing because the claims do not arise from just this video. *See* Br. at 9. The Amended Complaint makes clear that Plaintiffs perform the *Running Man* in videos, as well as during breaks at University of Maryland basketball games. Am. Comp., ¶¶ 9-13. The *Running Man* does not

³ While the Original Complaint (Dkt. No. 1) included copyright claims, the Amended Complaint does not. Because “an amended complaint supersedes the original complaint,” only the claims in the Amended Complaint are pertinent here. *Pac. Bell Tel. Co. v. linkLine Communs., Inc.*, 555 U.S. 438, 456 n.4 (2009).

need to be performed on video—it just may be from time to time. These are not all within copyright subject matter (for example, the performances are not fixed in a tangible medium) and thus readily distinguishable from Epic’s supporting cases. *See United States ex rel. Berge v. Bd. of Trs. of the Univ. of Ala.*, 104 F.3d 1453, 1463 (4th Cir. 1997) (copyright subject matter based on claims arising from copyrighted dissertation); *Lowry’s Reports, Inc. v. Legg Mason, Inc.*, 271 F. Supp. 2d 737, 754 (D. Md. 2003) (parties did not dispute that claims arising from reports fell within copyright subject matter); *Lions Gate Entertainment Inc. v. TD Ameritrade Services Co.*, 170 F. Supp. 3d 1249, 1264 (C.D. Cal 2016) (copyright subject matter based on claims arising from *Dirty Dancing* movie which included literary, musical, and choreographic works); *Fischer v. Viacom Int’l, Inc.*, 115 F. Supp. 2d 535, 541 (D. Md. 2000) (non-copyright claims arising from material “indistinguishable” from copyrightable written proposal).

Moreover, it makes little sense for copyright preemption to apply here because Plaintiffs do not allege any claims based on the Copyright Act. Thus, preemption would effectively leave Plaintiffs with no other adequate remedy at law, which is inconsistent with the reasons for preemption. *See Mercado Latino, Inc. v. Indio Prods.*, No. CV 13-01027 DDP (RNBx), 2013 U.S. Dist. LEXIS 83625, at *9 (C.D. Cal. June 12, 2013) (citations omitted) (claims preempted to the extent the Copyright Act provides an adequate remedy). For this reason alone, Epic’s copyright preemption argument fails.

Under the second prong of the preemption analysis, a claim is not preempted where it incorporates elements beyond those necessary to prove copyright infringement. *See Trandes Corp. v. Guy F. Atkinson Co.*, 996 F.2d 655, 659 (4th Cir. 1993) (detailing the “extra element” test). The elements of copyright infringement are that a plaintiff (1) owns a valid copyright, and (2) defendant copied original elements of the copyrighted work. *Id.* at 660 (citing *Feist*

Publications, Inc. v. Rural Tel. Serv. Co., 111 S. Ct. 1282, 1296 (1991).

Plaintiffs' claim based on Epic's misappropriation of their identities and likenesses (Count I) clearly contains "extra elements" that preclude preemption. *See McFarland v. Miller*, 14 F.3d 912, 918 (3d Cir. 1994) (extra elements in right of publicity include, *inter alia*, appropriating the value of plaintiff's likeness for commercial benefit); *Lawrence v. A.S. Abell Co.*, 475 A.2d 448, 451 (Md. 1984) (extra elements in misappropriation of likeness includes, *inter alia*, appropriates to his own use or benefit). Indeed, this is why courts have regularly held that copyright preemption does not apply to such claims. *See Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 623 (6th Cir. 2000) ("rights of publicity are generally consistent with the Copyright Act."); *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1027 (3d Cir. 2008) (no preemption because additional element in right of publicity claim beyond what copyright infringement requires); *Prima v. Darden Restaurants, Inc.*, 78 F. Supp. 2d 337, 352-53 (D.N.J. 2000) (same); *Estrada v. Toyota Motor Sales U.S.A., Inc.*, No. CV 08-05992 GAF (AJWx), 2009 WL 10671571, at *7 (C.D. Cal. Feb. 11, 2009) (no preemption because "[t]he right of publicity is the right to control the commercial exploitation of one's name or likeness ... as a general proposition, right of publicity claims are "intended to protect rights which cannot be copyrighted").

Epic's case in support, *Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1144 (9th Cir. 2006), is readily distinguishable. There, plaintiff objected to defendants' use of her voice even after she contracted with the defendant to reproduce her voice in a sound recording. The court acknowledged that at that point, the plaintiff "could have either retained the copyright, or reserved contractual rights in Elektra's use of the recording." *Id.* Finding copyright preemption, the court was concerned that "the developing right of publicity could easily supplant the

copyright scheme.” *Id.* at 1145. There is no such concern here, as Plaintiffs do not allege any copyright claims and, indeed, Epic has argued that such claims are not protected by copyright. *See supra* p. 7. Likewise, here there is no pre-existing relationship between Plaintiffs and Epic and no ability for Plaintiffs to decide to retain (or not) any copyrighted work.

Epic also fails to satisfy the second prong of the preemption analysis with respect to the unfair competition, trademark infringement, false designation of origin, and unjust enrichment claims (Counts II-VI, VIII). Here, Plaintiffs’ claims contain extra elements that go beyond merely reasserting rights under the Copyright Act. Plaintiffs have alleged that people have become confused and are likely to be deceived by the inclusion of the *Running Man* in a video game they do not endorse, and already are confused. *See, e.g.,* Am. Comp. ¶¶ 45-46, 54, 65, 75. Indeed, Epic is palming off Plaintiffs’ dance as their own. *See, e.g.,* Am. Comp., ¶¶ 54, 75, 90. And it would be unjust and inequitable for Epic to retain the benefits of these actions without compensating Plaintiffs. *See, e.g.,* Am. Comp., ¶¶ 47, 61-62.

Courts have consistently held that these extra elements preclude preemption. *See U-Neek, Inc. v. Wal-Mart Stores, Inc.*, 147 F. Supp. 2d 158, 174 (S.D.N.Y. 2001) (the extra element of “actual confusion” precludes copyright preemption); *Nicole, Inc. v. B.L.K. Int’l, Inc.*, No. CV 15-01892-RGK (EX), 2015 WL 12826459, at *4 (C.D. Cal. Jun. 25, 2015) (no preemption because the unfair competition “claim contains an element not found in the Copyright Act—whether members of the public are likely to be deceived”); *Butler v. Target Corp.*, 323 F. Supp. 2d 1052, 1057 (C.D. Cal. 2004) (allegation that distorted lyrics confused plaintiffs’ fans into believing they endorsed Target Stores constitutes an “extra element” that precludes preemption); *Henley v. Devore*, No. SACV 09-0481-JVS, 2009 WL 10697982, at *8 (C.D. Cal. Jul. 8, 2009) (no preemption because the public might associate plaintiff with video and “legislative history of

the Copyright Act” makes clear that it is “not intended to preempt common law protection in cases involving activities such as false labeling, fraudulent representation, and palming off”); *Aagard v. Palomar Builders, Inc.*, 344 F. Supp.2d 1211, 1217 (E.D. Cal. 2004) (claim not preempted because “customers allegedly believed they were purchasing [cross-complainant’s] Plans”); *Criterion 508 Solutions, Inc. v. Lockheed Martin Servs.*, 806 F. Supp. 2d 1078, 1107-08 (S.D. Iowa 2009) (unjust enrichment added extra elements that precluded preemption); *Capital Concepts, Inc. v. Mt. Corp.*, No. 3:11-CV-00036, 2012 U.S. Dist. LEXIS 182874, at *56-57 (W.D. Va. Dec. 30, 2012) (same). These cases urge the same result here.

Next, Epic cites to a series of cases suggesting that Lanham Act claims are preempted by the Copyright Act. However, those cases are easily distinguishable. In *Lions Gate Entm't Inc. v. TD Ameritrade Servs. Co., Inc.*, 170 F. Supp.3d 1249 (C.D. Cal. 2016), the court distinguished the case where the plaintiff was “claiming solely that the use of a famous line ... as modified and used in advertising was a violation of the plaintiffs' trademark rights in using that phrase” from a different type of case where “the use of something so closely associated to their famous persona was a misappropriation of their publicity and a false endorsement where the ‘mark’ for Lanham Act purposes is their celebrity identity.” *Id.* at 1269. The latter theory was “not similar to the one espoused by Plaintiff in this case, and not necessarily covered by *Dastar*.”⁴ *Id.* Again, here Plaintiffs do not allege that someone stole a famous line from a movie (a copyrighted work), but instead that the *Running Man* was a use so closely associated to their famous personas that

⁴ As for Epic’s reliance on *Dastar*, Epic “overstate[] the holding of *Dastar*. The question presented in that case was the meaning of ‘origin’ as used in section 1125(a), not, as [Defendants] appear[] to suggest, when the law of copyright preempts the law of trademark. . . . [t]he Court did not hold ... that a Lanham Act claim is necessarily precluded because copyright interests are also involved.” *Micro/sys, Inc. v. DRS Techs., Inc.*, No. CV143441DMGAJWX, 2015 WL 12748630, at *4 (C.D. Cal. Feb. 13, 2015).

Defendants' use of the dance is "a false endorsement."⁵

B. Plaintiffs State a Right of Publicity Claim

1. Maryland's Law Applies

Maryland applies the *lex loci delicti* choice of law analysis, which applies the substantive law of the state where the wrong occurs. *See Rockstroh v. A.H. Robins Co.*, 602 F. Supp. 1259, 1262 (D. Md. 1985). Here, the *Running Man* was made famous and became associated with Plaintiffs while they played collegiate basketball at the University of Maryland. Am. Comp., ¶¶ 9-13. Since this dance is what Plaintiffs allege that Epic misappropriated, Maryland's substantive law applies. *See Barnhart v. Paisano Publications, LLC*, 457 F. Supp. 2d 590, 592-93 (D. Md. 2006) (Maryland's substantive law applies in tort arising from a photograph was taken at an event in Maryland).

2. Plaintiffs' Right of Publicity Claim Proceeds Regardless of Which State's Law Applies

Regardless of whether Maryland, Massachusetts, or New Jersey law applies, all of these states recognize Plaintiffs' right of publicity claim. As an initial matter, Epic does not argue that Maryland or New Jersey would fail to recognize Plaintiffs' right of publicity claim under the common law. *See Br.* at 13. To the extent Epic tries to argue this for the first time in its reply brief, it is waived. *See United States v. Williams*, 445 F.3d 724, 736 (4th Cir. 2006) (refusing to

⁵ The other cases cited by Epic in support of this argument are inapposite. *See Slep-Tone Entm't Corp. v. Wired for Sound Karaoke & DJ Servs., LLC*, 845 F.3d 1246, 1250 (9th Cir. 2017) (no consumer confusion possible as to source of goods because "patrons [cannot] see the physical good in question—the digital file that presumably resides on the hard drive of the bar's karaoke system"); *Sybersound Records, Inc. v. UAV Corp.*, 517 F.3d 1137, 1150 (9th Cir. 2008) (preemption in part because plaintiff did not have "standing under the federal copyright act" and did not "pursue [n]on-infringement claims"); *Mays & Assocs., Inc. v. Euler*, 370 F. Supp. 2d 362, 365, 370-71 (D. Md. 2005) (Lanham Act claims did not cover subject of asserted claims).

consider issue first raised in reply brief) (citation omitted).

With respect to Massachusetts, Epic asserts that the state does not recognize the common law right of publicity (Br. at 13 n.7), but fails to acknowledge that Massachusetts recognizes four forms of invasion of privacy, including misappropriating a person's name or likeness. *Minovitch v. Battin*, Dkt. No. 00-5159(J), 2005 Mass. Super. LEXIS 351, at *16 n.7 (Mass. Super. Ct. July 15, 2005). Under the statutory right of publicity, Epic acknowledges that misappropriation of a person's "name, portrait, or picture" rests on whether that person can be identified through "identifying physical characteristics" in the accused work. *See* Br. at 13 (citation omitted).

Plaintiffs do not contend that an in-game *Fortnite* avatar looks like them. Rather, it is the *Running Man* dance emote which serves as an "identifying physical characteristic." *See, e.g.,* Am. Comp., ¶ 37. The cases are legion which teach that such identifying characteristics can go beyond just a person's face or image. In *Newcombe v. Adolf Coors Co.*, the primary identifying characteristic in the picture in question was a baseball pitcher's stance. 157 F.3d 686, 692 (9th Cir. 1998). In *White v. Samsung Elecs. Am., Inc.*, the accused work contained a clearly inhuman robot that looked nothing like *Wheel of Fortune* hostess Vanna White. 971 F.2d 1395, 1396 (9th Cir. 1992). Despite this, the court found that the combination of identifying characteristics, including the robot's wig, gown, jewelry, and pose next to a game board precluded a finding of summary judgment against the plaintiff. *Id.* at 1396, 1399. And in *Motschenbacher v. R. J. Reynolds Tobacco Co.*, the identifying characteristics came not from the plaintiff's face or even body, but from his car, which included "the white pinstriping, the oval medallion, and the red color of plaintiff's car," that would make viewers identify the car in question with the plaintiff. 498 F.2d 821, 822, 827 (9th Cir. 1974).

Epic points to irrelevancies that fail to negate the *Running Man* as an identifying

characteristic and is associated with Plaintiffs. If all it took was for other people to perform this dance to negate it as an identifying characteristic, as Epic suggests (Br. at 14), this would apply equally to every celebrity's face when people dress up as them for Halloween. Likewise, whether or not Plaintiffs created the *Running Man* (*id.*), the public still readily associates that signature dance with Plaintiffs. It is doubtful that Vanna White created her signature letter-flipping, pose, hair, and other accoutrements, yet these characteristics were readily identified with her. *See White*, 971 F.2d at 1396. *Lohan v. Take-Two Interactive Software, Inc.* also does not help them. 31 N.Y.3d 111, 122-23 (N.Y. 2018). There, the accused work did not contain any identifying characteristic of the plaintiff because there was simply nothing recognizable about her. The accused character was a generic “twenty something” year old woman that did not have any features readily associated with anybody in particular. *See id.*

Finally, New Jersey applies the Transformative Use Test in right of publicity cases. *See Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 165 (3d Cir. 2013) (applying Transformative Use Test in the Third Circuit). However, Epic does not cite any case showing that Maryland or Massachusetts apply this test—because they do not do so. As discussed further below, Epic's blatant theft of the *Running Man* is not excused even under the Transformative Use Test.

3. Epic's Misappropriation of the Running Man is Not a Transformative Use

The right of publicity is undoubtedly a valuable right. *See Hart*, 717 F.3d at 159 (the right of publicity “offers protection to a form of intellectual property that society deems to have social utility”) (citing *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 399 (2001)); *McFarland*, 14 F.3d at 919 (“many prominent persons (especially actors and ball players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements,

popularizing their countenances, displayed in newspapers, magazines, buses, trains and subways”) (quoting *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953)). Thus, just because something warrants some level of First Amendment protection does not mean that it receives absolute protection if it encroaches on an individual’s right of publicity. See *Comedy III*, 25 Cal. 4th at 399. The Transformative Use Test balances the valuable interest in an individual’s right of publicity against the interests preserved by the First Amendment. *Hart*, 717 F.3d at 163-65.

This test focuses on whether the accused work sufficiently transforms the plaintiff’s identity or likeness, and the specific aspects of the work that shed light on whether it was created to exploit the plaintiff’s identity or likeness. *Id.* at 1363. The defense is a question of fact and only available as a matter of law if no trier of fact could conclude that there was no transformative use. *Hilton v. Hallmark Cards*, 599 F.3d 894, 910 (9th Cir. 2010) (citing *Comedy III*, 25 Cal. 4th at 409).

Several cases applied this test in the context of video games and are illustrative. In *Hart*, the Third Circuit found there was no transformative use in a digital avatar representing a college football player in the *NCAA Football* video games. Despite not reproducing the real-world player’s actual face, other identifying characteristics, including hair color, hair style, skin tone, worn accessories, and vital and biographical details, and position connected the digital avatar to the real-world player. 717 F.3d at 166-67; see also *Keller v. Elec. Arts Inc.*, 724 F.3d 1268, 1278 (9th Cir. 2013) (Ninth Circuit reaching the same conclusion as *Hart* when also addressing a “materially identical challenge” involving digital avatars in the *NCAA Football* video games)

Likewise, the court in *No Doubt v. Activision Publishing, Inc.* found that Transformative Use did not form a sufficient defense to misappropriation by the use of digital recreations of the

musical group *No Doubt* in the *Band Hero* video game. 192 Cal. App. 4th 1018, 1034-35 (Cal. Ct. App. 2011). There, the court found that other expressive elements in the game, such as having the band perform songs in fanciful settings such as outer space or even have the band perform songs they objected to performing, were not sufficiently transformative. *Id.*

Epic's misappropriation of the *Running Man* is in no way transformative. As an initial matter, Epic's contention that the *Running Man* and the in-game *Fortnite* dance emote (also called the "Running Man") are different from each other in any meaningful way cannot withstand scrutiny. This is made plain by a video showing the *Running Man* performed alongside its counterpart in *Fortnite*. Ex. 1 at 0:31 – 1:12. The in-game use of the *Running Man* was literal and conventional, not manipulated, distorted, or transformed in any way. Plaintiffs are famous for performing the *Running Man* in the real world (Am Comp., ¶¶ 2, 10-13), and the in-game avatars performing the *Running Man* are doing the exact thing that Plaintiffs are famous for. This is not transformative. *See Hart*, 717 F.3d at 166 (not transformative when the digital avatar does what the real-world counterpart did); *No Doubt*, 192 Cal. App. 4th at 1034 (not transformative when "no matter what else occurs in the game during the depiction of the No Doubt avatars, the avatars perform rock songs, the same activity by which the band achieved and maintains its fame").

The lack of any significant transformative element is further seen in the in-game *Fortnite* electronic storefront where the dance is advertised and sold. As shown in Ex. 1 (0:31 – 0:52), the in-game storefront advertises and sells the *Running Man* dance being performed by different avatars that can be changed; it is the dance that is featured, not the characters. The dance is displayed in a loop and the player is unable to control the character in any way during the performance, which is an advertisement designed to sell the user the emote or Battle Pass, either

of which unlock the emote. And in the unlikely event that there was any doubt what *Fortnite*'s "Running Man" dance emote is supposed to be, Epic named it the same name and includes a caption with the dance emote that reads "The challenge is to never stop running," a clear reference to Plaintiffs' social media "challenge" to perform the *Running Man*. Am. Comp., ¶ 11; Ex. 1 at 0:32 – 0:34.

That Plaintiffs are famous for the *Running Man* dance and readily associated with it (Am. Comp., ¶¶ 9-13), and that something so readily identifiable with them was what was taken wholesale by Epic, make their supporting cases readily distinguishable. *See Mitchell v. Cartoon Network, Inc.*, Civ. No. 15-5668, 2015 WL 12839135, at *5 (D.N.J. Nov. 20, 2015) (nothing about the accused character was readily identifiable with plaintiff—which plaintiff admitted—outside of generic features like "long black hair and a beard"); *Kirby v. Sega of America, Inc.*, 144 Cal. App. 4th 47, 51 (Cal. Ct. App. 2006) (plaintiff admitting that she had "no singular identity" and that this "lack of stasis is inconsistent with a claim of appropriation"); *Sivero v. Twentieth Century Fox Film Corp.*, No. B266469, 2018 WL 833696, at *10 (Cal. Ct. App. Feb. 13, 2018) (accused cartoon character had "no points of resemblance" to plaintiff).

Epic further argues that the *Running Man* is but a small part of *Fortnite*, which weighs toward a finding of transformative use. Br. at 17. But this same argument was put forth and soundly rejected by the *Hart* court as an "improperly inquiry." *Hart*, 717 F.3d at 169. The correct inquiry is to look to how the plaintiff's identity is utilized or altered by other parts of a work; entirely unrelated elements do not form part of this inquiry. *Id.* As the *Hart* court explained:

To hold otherwise could have deleterious consequences for the state of the law. Acts of blatant misappropriation would count for nothing so long as the larger work, on balance, contained highly creative elements in great abundance. This concern is particularly acute in the case of media that lend themselves to easy partition such

as video games. It cannot be that content creators escape liability for a work that uses a celebrity's unaltered identity in one section but that contains a wholly fanciful creation in the other, larger section.

Id.

Hart's concern that this issue is “particularly acute” in video games is much more so in video games such as *Fortnite*, which lends itself to even greater partition than the games at issue in *Hart* and *Keller*. Those games offered players a complete package at around sixty dollars. In contrast, *Fortnite* is entirely free to play and restricts much of its content. Epic makes its money selling in-game access to things like the *Running Man* (which can cost approximately five dollars when purchased alone or as part of a larger bundle of other in-game features). *See supra* Part II. And as discussed above, this portion of the game that Epic sells separately, the *Running Man*, is literally copied from its real-world counterpart—exactly the “blatant misappropriation” that the *Hart* court warned about. Thus, the fact that many other elements in the game exist does not play a part in the transforming use analysis, particularly where the dance emote at issue is the subject of a discrete purchase and feature within the game.

Thus, it is immaterial that *Fortnite* avatars fight in a battle royale and utilize various weapons to kill their opponents, while Plaintiffs clearly do not do this in the real world. *See Br.* at 17. The in-game *Running Man* dance emote is still a literal recreation of its real-world counterpart that Plaintiffs are famous for, and this is not transformative enough to immunize the work from Plaintiffs' claims. *See Hilton*, 599 F.3d at 911 (using Paris Hilton's oversized head on a cartoon body and placing her in a different setting does not justify transformative use defense as a matter of law). Indeed, Epic's same argument was rejected in *No Doubt*. Like here, the defendants in that case argued that having the *No Doubt* avatars perform songs in fanciful settings (including in outer space) and even perform songs that the real-world band objected to performing was sufficiently transformative. *No Doubt*, 192 Cal. App. 4th 1034-35. But the

court there concluded that these elements failed to transform the *No Doubt* avatars into anything other than depictions of the real world band members. *See id.*

Lastly, Epic’s contention that *Fortnite*’s value comes from Epic’s “creativity, skill, and reputation,” rather than the dance emote, is misplaced. To start, whether the marketability and economic value of the accused work derives primarily from the fame of the plaintiff, or some other element, is merely a “secondary question.” *Hart*, 717 F.3d at 163. That aside, *Fortnite*’s microtransaction business model means that the accused work in question is not *Fortnite* as a whole, but the dance emote itself. As discussed above, that is because the dance emote is a discrete digital good that is sold separately, which makes it easily distinguishable from Epic’s supporting cases. *See de Havilland v. FX Networks, LLC*, 21 Cal. App. 5th 845, 850 (Cal. Ct. App. 2018) (accused character part of a television series, with presumably no way for consumers to purchase only that character); *Sivero*, 2018 WL 833696, at *1 (same). In the instant case, a player *only* gets the dance emote—or any other digital good or feature—when they purchase it in *Fortnite*’s in-game store. It is logical to conclude that selling the *Running Man* dance emote, naming it the same as the dance for which Plaintiffs are famous for, and digitally copying it were done to exploit and profit from the fame that Plaintiffs had created. *See No Doubt*, 192 Cal. App. 4th at 1035 (“insofar as the depiction of No Doubt is concerned,” other elements of the game are subordinated to the goal of commercially exploiting No Doubt’s fame).

Accordingly, like in *Hart*, *Keller*, and *No Doubt*, the Motion fails because Epic cannot establish that no trier of fact could find that the use of the *Running Man* in *Fortnite* was not transformative.

C. *Rogers v. Grimaldi* Does Not Bar Plaintiffs’ Trademark, Unfair Competition, and Unjust Enrichment Claims

Epic’s argument that Plaintiffs’ trademark, unfair competition, and unjust enrichment

claims should be barred under the test articulated in *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) fails. As an initial matter, it is unclear whether this test applies in the Fourth Circuit or Maryland. Even if it does, Epic’s argument fails because (1) the test under *Grimaldi* does not apply when the use was not transformative, (2) the test under *Grimaldi* does not apply to uses of trademarks solely for commercial purposes, and (3) even if the test under *Grimaldi* does apply, there is no artistic relevance in Epic’s use of the *Running Man*, and it is a question of fact whether Epic’s game explicitly misleads consumers.

First, Epic’s unfair competition claims are not subject to the *Grimaldi* test because Defendants’ use was not transformative. *See supra* Part IV.B.3. As a matter of law, the *Grimaldi* test does not apply to such claims when their use “is not transformative.” *No Doubt*, 192 Cal. App. 4th at 1039–40. This is because the *Grimaldi* test is based on “the over-arching conclusion ... that the public interest in avoiding consumer confusion must be balanced against the public interest in free expression.” *Id.* However, where there is no transformative use, “the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Id.* (holding “the trial court did not err in denying [defendant’s] motion to strike [plaintiff’s] section 17200 claim” under *Grimaldi* test when use was non-transformative)

Second, the *Grimaldi* “test applies only to artistic or expressive works; it is not applicable to commercial works such as a traditional advertisement.” *Hush Hush Sound, Inc. v. H & M Hennes & Mauritz LP*, No. 2:17-CV-07668-RGK-SS, 2018 WL 4962086, at *3 (C.D. Cal. Jan. 26, 2018) (citing *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1241 (9th Cir. 2013); 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:144.50 (5th ed. 2017)). Indeed, commercial speech is afforded less extensive First Amendment protection than non-commercial speech. *Zauderer v. Office of Disciplinary Counsel of Supreme Court*, 471 U.S. 626,

637 (1985).

Hush Hush is instructive. In *Hush Hush*, plaintiffs that were part of a disc jockey group brought suit against H&M for the use of their group's name on products. *Id.* at *1. In response, H&M argued plaintiffs' claims should be barred under the *Rogers* test. *Id.* at *3. This court ruled that the *Rogers* test did not even apply to plaintiff's causes of action because H&M "does not argue that it is expressing any message about itself by selling the infringing garments." *Id.* at 2. Accordingly, the sale of the infringing product did "not serve a predominantly expressive purpose." *Id.*⁶

Here, just as in *Hush Hush*, Epic has made no showing that the decision to sell the *Running Man* reflects an expression of Epic or its game. Instead, it is more likely that the *Running Man* was chosen to capitalize on Plaintiffs' fame and publicity (*see supra* p. 19), so that their fans will buy the dance. It was blatant a money grab, and such "expressions" are not protected by the First Amendment or subject to the *Rogersi* test.

The first prong of the *Rogers* test permits a plaintiff's cause of action to go forward if the use of the likeness "has no artistic relevance to the underlying work whatsoever." *Rogers*, 875 F.2d at 999. However, as the *Rogers* court identified, "[p]oetic license is not without limits. The purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the

⁶ Epic may argue on reply that video games are creative expressions and thus are, as a matter of law, protected by the First Amendment. A closer look at why courts have ruled that some aspects of video games are protected by the First Amendment makes it clear that the selling of someone's dance wholly independent from the gameplay is not what courts had in mind. *See, e.g., Brown*, 724 F.3d at 1241 (some video games are protected under the First Amendment because they "communicate ideas—and even social messages—through many familiar literary devices (such as characters, dialogue, plot, and music) and through features distinctive to the medium (such as the player's interaction with the virtual world)") It is unclear how purchasing the *Running Man* communicates a social message through literary devices. As the court in *Brown* suggested, there "is a line to be drawn between expressive video games and non-expressive video games." *Id.*

source of the product.” *Id.* at 997. Therefore, in cases where the use of a likeness is solely for revenue generating purposes, or the use could confuse consumers, courts find the use has no artistic relevance and allow plaintiff’s claims to proceed. *See, e.g., Hush Hush*, 2018 WL 4962986, at *3 (“Even if the [*Rogers*] test applied, H&M’s arguments fail to establish artistic relevance” because H&M made “no showing that the [likeness] had genuine relevance to the message expressed by the [product]” and instead it was “more likely that [the likeness] was chosen to capitalize on the publicity value of Plaintiffs’ mark, so that fans of the musical group would buy [the product].”); *Parks v. LaFace Records*, 329 F.3d 437, 453-54 (6th Cir. 2003) (song title “Rosa Parks is not relevant to the content of the song in question” because while “[t]he use of this woman’s name unquestionably was a good marketing tool ... its use could be found by a reasonable finder of fact to be a flagrant deception on the public regarding the actual content of this song and the creation of an impression that Rosa Parks, who had approved the use of her name in connection with the Tribute album, had also approved or sponsored the use of her name on Defendants’ composition.”); *Warner Bros. Entm’t v. Glob. Asylum, Inc.*, No. CV 12-9547 PSG (CWx), 2013 WL 12114836, at *10-11 (C.D. Cal. Jan. 29, 2013), *aff’d sub nom. Warner Bros. Entm’t v. Glob. Asylum, Inc.*, 544 F. App’x 683 (9th Cir. 2013) (first prong of *Roegrs* not satisfied because unlike case where trademark was used “to create a neighborhood that was evocative of Los Angeles in order to provide players with a digital recreation of the city” in line with the “goal of the video game [which] was to allow players to ‘experience’ Los Angeles,” here video made “no attempt to create a world similar to” the trademark and the mark “has no apparent connection to the underlying work” but was “merely borrow[ing] another’s property to get attention”).

Parks v. LaFace Records is instructive. In *Parks*, Rosa Parks brought suit against

Outcast and the record producer for using her name in a song title. *Id.* at 441. In response, defendants argued that Parks' claims were barred under *Rogers*. *Id.* at 444. The Sixth Circuit reversed the district court, determining that "the artistic relationship between the title and the content of the song is certainly not obvious." *Id.* at 452. This was because the lyrics and content of the song had "absolutely nothing to do with Rosa Parks." *Id.* The Sixth Circuit also noted that using Rosa Parks' name also came with "the marketing power of an icon of the civil rights movement" and thus "[c]hoosing Rosa Parks' name as the title to the song unquestionably enhanced the song's potential sale to the consuming public." *Id.* at 453. Therefore, the court determined that using "the phrase 'move to the back of the bus' in the lyrics of this song ... does not justify, as a matter of law, the appropriation of Rosa Parks' name for the title to the song." *Id.*

Here, just as in *Parks*, the *Running Man* has no artistic relevance in the context of the video game and is only included to make money. Epic does not argue, nor could they, that the *Running Man* has anything to do with video games, that it makes gameplay more realistic, or that it is essential to the overall game experience. Instead, the *Running Man* dance emote is just another way for Defendants to make money off of a video game that draws players in with a free-to-play game and encourages them to purchase such things in-game.⁷

⁷ Epic's cases are distinguishable. First, in *Roxbury Entertainment*, the court relied on the fact that defendants "introduced evidence demonstrating at least some relationship between the mental imagery associated with the term 'Route 66,' e.g., road trips, cross-country travel, and the content of Defendants' movie." *Roxbury Entm't v. Penthouse Media Grp., Inc.*, 669 F. Supp.2d 1170, 1176 (C.D. Cal. 2009). Here, Epic has made no such showing. Second, *ESS* is the same case that was distinguished by *Warner Brothers*, because the trademark use in *ESS* was necessary "in line with the goal of the video game." *Warner Brothers*, 2013 WL 12114836, at *11 (citing *ESS*, 547 F.3d at 1096). Just as in *Warner Brothers*, there is no suggestion here that the *Running Man* is necessary in line with the goal of Epic's video game. Finally, in *Novalogic, Inc. v. Activision Blizzard*, the court specifically cited to the fact that the use of the alleged

As to the second prong of the *Rogers* test, even if there is slight artistic value in having the *Running Man* in *Fortnite*, Epic cannot show as a matter of law that it does not explicitly mislead players as to the source or content of this dance emote. The instant case is readily distinguishable from *Dillinger, LLC v. Elec. Arts Inc.*, where the plaintiff could only show that a single text line of the name “Dillinger” was used in the accused video game. *See* No. 1:09-cv-1236-JMS-DKL, 2011 WL 2457678, at *7-8 (S.D. Ind. 2011). Here, in addition to naming their in-game dance emote *the same name* after Plaintiffs and their dance became famous (*see, e.g.,* Am. Comp., ¶ 11), as well as copying the dance entirely, Epic also inserted a caption for this dance emote that players can see when they browse the in-game shop. The caption, which reads “the challenge is to never stop running,” is an explicit connection and reference to Plaintiffs’ social media “challenge” to perform the *Running Man*. Am. Comp., ¶ 11; Ex. 1 at 0:32 – 0:34; *see also Rogers*, 875 F.2d at 1001. And whether or not the dance emote is a small part of *Fortnite* (Br. at 22), that is immaterial as the accused work is not a part of a game that players purchase, but subject of a direct digital goods purchase. *See supra* Part II. Further, discovery needs to be conducted in order to determine whether consumers are explicitly misled by the inclusion of the *Running Man*. Accordingly, it cannot be said, as a matter of law, that the *Running Man* does not explicitly mislead players as to the source of the dance.

D. Plaintiffs State a Claim for Trademark Infringement and Dilution

Epic’s attempt to dismiss Plaintiffs’ claims for trademark infringement and Dilution must be rejected by this Court. Importantly, Epic’s argument that Plaintiffs have no trademark rights

infringing mark “give[s] users . . . a sense of a particularized reality of being part of an actual elite special forces operation and serve as a means to increase specific realism of the game.” *Novalogic, Inc. v. Activision Blizzard*, 41 F. Supp.3d 885, 900–01 (C.D. Cal. 2013). Again, there is no suggestion by Epic that the *Running Man* adds to the “realism” of playing battle royale game.

in the *Running Man* is unsupported by the law. Indeed, Defendants do not cite a single case that indicates that a dance cannot be trademarked. Nor do any of Plaintiffs' trademark infringement claims (Counts V through VI) rely upon use of "likeness" as Epic argues; rather, these counts distinguish Plaintiffs' likeness and the dance. Br. at 23; *compare* Am. Comp., ¶¶ 63-80. As described in the Amended Complaint, Plaintiffs used the dance in commerce by posting videos of themselves on social media sites. Am. Comp., ¶¶ 10. Therefore, Defendants' arguments regarding the lack of existence of goods and services associated with the moot must fail.

Epic's string cite of cases also fail to support its nonsensical argument that "the Dance Step has become a trademark for the Dance Step itself." In *EMI Catalogue Partnership v. Hill*, EMI claimed that a "song itself serve[d] as a 'symbol or device' that indicates its source," and the Court "h[e]ld that a musical composition cannot be protected as its own trademark under the Lanham Act." 228 F.3d 56, 63-64 (2d Cir. 2000). This case does not involve a musical composition nor do Plaintiffs allege that the dance serves as its own trademark. Rather, the *Running Man* identifies the source of entertainment services: performances by Plaintiffs. Epic infringes this trademark in its advertising, use, and sale of the infringing *Running Man* emote, a virtual good.

Epic also cites to *Radiance Foundation, Inc. v. N.A.A.C.P.*, which involved NAACP trademarks that had been confused with respect to "positions on political or social issues" (National Association for the Advancement of Colored People vs. National Association for the Abortion of Colored People)—not in the context of confusion regarding the sale of goods and services. 786 F.3d 316, 327 (4th Cir. 2015). Unlike *Radiance*, the case at bar does not involve political or social views but goods and services: advertising, use, and sale of the infringing emote in the *Fortnite* marketplace. Similarly, in *Hughes v. Design Look Inc.*, "[n]o evidence was

presented to show that any of the[] twelve images had ever been associated with any product or service put out by Warhol.” 693 F. Supp. 1500, 1506 (S.D.N.Y. 1988) In contrast, Plaintiffs here used the *Running Man* to identify their performances.

The cases cited by Epic in support of the notion that Plaintiffs do not have trademark rights are also inapposite. In *ETW Corp. v. Jireh Pub., Inc.*, Tiger Woods’s licensing agent claimed it had trademark rights in Woods’s image and likeness and “claim[ed] protection under the Lanham Act for any and all images of Tiger Woods,” which would have the effect of making “Woods himself as a walking, talking trademark” 332 F.3d 915, 922 (6th Cir. 2003). Plaintiffs here allege limited trademark rights in a series of movements, not in their faces. Further, unlike *ETW*, this case does not involve allegations of infringement in a creative work, like a painting; rather, the *Fortnite* electronic marketplace sells a digital copy of Plaintiffs’ *Running Man* that is at issue here.

In *Pirone v. MacMillan, Inc.*, Babe Ruth’s daughters filed a lawsuit alleging federal and common law trademark infringement and unfair competition relating to use of Babe Ruth’s photographs in *The 1988 MacMillan Basement Engagement Calendar*. 894 F.2d 579, 581 (2d Cir. 1990). Plaintiffs did not allege any ownership interest in the photographs used in the calendar. *Id.* While the 2nd Circuit conceded that “[u]nder some circumstances, a photograph of a person may be a valid trademark,” but ultimately affirmed summary judgement because Plaintiffs “assert[ed] rights in every photograph of Ruth.” *Id.* at 583. Plaintiffs here make no such assertion; the trademark rights at issue here are a relatively short series of movements that identify Plaintiffs’ performance which were blatantly copied by Epic.

Finally, with the same erroneous circular logic that “the Dance Step has become a trademark for the Dance Step itself,” Epic argues that Plaintiffs “have not and cannot argue that

Epic Games has used the Dance Step as a mark to identify the source of Epic Games' own goods or services—that is, ***to identify the source of Fortnite***.” Br. at 24 (emphasis added). Clearly the *Running Man* is not used to identify the source of *Fortnite* itself. But Epic completely ignores the fact that *Fortnite* includes an electronic marketplace akin to Amazon.com, where it offers virtual goods to consumers. One of the virtual goods available in the electronic marketplace was the *Running Man*, which upon purchase may be used in the *Fortnite* battle royale in between shooting at other players.

V. CONCLUSION

For the foregoing reasons, Plaintiffs respectfully request that the Court deny Epic's Motion to Dismiss in its entirety.⁸

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Respectfully submitted,

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⁸ Epic unusually asks the Court for dismissal with prejudice should they succeed on their Motion. Br. at 25. However, “the purpose of pleading is to facilitate a proper decision on the merits” and dismissal with prejudice is generally proper only where “there is no set of facts the plaintiff could present to support his claim.” *Weigel v. Maryland*, 950 F. Supp. 2d 811, 825-26 (D. Md. 2013) (citations omitted).

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